

### REMARKS

The Examiner rejected claims 1-3 and 8-15 under 35 U.S.C. § 101; rejected claims 1-15 under 35 U.S.C. § 112 ¶ 1; rejected claims 1-3 and 8-15 under 35 U.S.C. § 102(b) as being anticipated by Perholtz et al. (U.S. Patent No. 5,732,212 A) (hereinafter “Perholtz”). Applicants amend claims 1 and 15. Claims 1-15 remain in the case.

#### Rejection of Claims 1-3 and 8-15 under 35 U.S.C. § 101

The Examiner maintained the rejection of claims 1-3 and 8-15 under 35 U.S.C. § 101 on the ground that they are directed to non-statutory subject matter. The Examiner writes:

“The result claimed by Applicant is the entering of parameters. Although Applicant mentions a ‘measurement task’, Applicant does not actually measure anything in the claims. there’s [sic] no real world data in the claims and the result does not reach the real world to have a ‘useful, concrete, and tangible result.’” (Final Rejection, page 3, ¶ 4)

Applicants submit that the Examiner has misidentified the result of the claims. As discussed in Applicants’ previous response, the result is: a protocol tester configured to perform a measurement task, i.e., a test and measurement instrument adapted to a specific use, i.e., a machine. In order to make this result more clear and apparent, Applicants amend independent claims 1 and 15 by expressly reciting it in the body of the claims as a final step and means, respectively:

1. (Currently Amended) A method of configuring a protocol tester to perform a measurement task comprising the steps of:

- a) displaying a problem field on a display device of the protocol tester, the problem field having a plurality of network elements for a telecommunication network;
- b) graphically activating one of the network elements;
- c) displaying a plurality of measurement tasks on the display device which are possible with respect to the activated network element;
- d) graphically selecting one of the measurement tasks; ~~and~~
- e) entering parameters level by level in lower levels starting from a level of the activated network element, with the parameters not specified by the user being occupied by standard values[-] ; and
- f) configuring the protocol tester to perform the selected measurement task on the activated network element using the specified parameters.

15. (Currently Amended) A protocol tester comprising:  
means for displaying a problem field, the problem field having a plurality of network elements for a telecommunication network;  
means for graphically activating one of the network elements;  
means for displaying a plurality of measurement tasks of the protocol tester which are possible with respect to the activated network topology element;  
a storage device in which standard values for parameters are stored, which standard values may serve for the configuration of the measurement task;  
means for graphically selecting one of the measurement tasks; and  
means for entering further parameters level by level in lower levels starting from a level of the activated network element, with the parameters not specified by the user being occupied by standard values[-] ; and  
means for configuring the protocol tester to perform the selected measurement task on the activated network element using the specified parameters.

No new matter has been added through these amendments because this subject matter is supported by the specification at page 5, lines 18-20 and page 8, lines 4-6 and the preambles of claims 1 and 15.

Now certainly, a test and measurement instrument, e.g. an oscilloscope, a logic analyzer, or a protocol tester, is statutory subject matter because it has a “well-established utility,” i.e., one of ordinary skill in the art of test and measurement equipment appreciates its utility. MPEP § 2107 Likewise, a test and measurement instrument is statutory subject matter because it itself is a “useful, concrete, and tangible result” for all the reasons discussed in the previous response. This is true regardless of whether or not a practical application, e.g., “measuring a real-world signal with the instrument,” is expressly recited in the claim. Similarly, the result of Applicants’ claimed invention, a protocol tester configured to perform a measurement task, is also statutory subject matter.

Accordingly, independent claims 1 and 15 are directed to statutory subject matter. Applicants therefore request that the rejection of claims 1 and 15 under 35 U.S.C. § 101 be withdrawn.

Claims 2, 3, and 8-14 are in condition for allowance because they depend from claim 1, which is in condition for allowance as discussed above. Applicants therefore request that the rejection of claims 2, 3, and 8-14 under 35 U.S.C. § 101 be withdrawn.

Rejected of Claims 1-15 under 35 U.S.C. § 112 ¶ 1

The Examiner rejected claims 1-15 under 35 U.S.C. § 112 ¶ 1 on the ground that such a rejection is required due to the rejection under 35 U.S.C. § 101 discussed above.

The rejection under 35 U.S.C. § 112 ¶ 1 is no longer required because the rejection under 35 U.S.C. § 101 has been overcome. Applicants therefore request that the rejection of claims 1-15 under 35 U.S.C. § 112 ¶ 1 be withdrawn.

Rejection of Claims 1-3 and 8-15 under 35 U.S.C. § 102(b)

The Examiner rejected claims 1-3 and 8-15 under 35 U.S.C. § 102(b) as being anticipated by Perholtz.

Applicants maintain that Perholtz does not describe a “protocol tester” as recited in independent claims 1 and 15. A protocol tester is a type of test and measurement equipment used for testing communication network protocols, well-known to those of ordinary skill in the art. An example of a protocol tester is a K1297/K1205 Series Protocol Tester available from Tektronix, Inc. A brochure describing the K1297/K1205 (dated February 8, 2002) is attached hereto and is also available at [http://www.tek.com/site/ps/2F-15355/pdfs/2FW\\_15355.pdf](http://www.tek.com/site/ps/2F-15355/pdfs/2FW_15355.pdf).

The Examiner writes that Perholtz anticipates a protocol tester at column 39, lines 26-39. Applicants respectfully disagree. The cited text merely describes a protocol, i.e., a set of rules for communication, that a keyboard uses to communicate with a personal computer. (column 39, lines 13-25) The mere fact that Perholtz makes use of a protocol does not mean that Perholtz anticipates a “protocol tester.” Indeed, many modern digital devices communicate using protocols, e.g. computers in general, but one of ordinary skill in the art would not consider them to anticipate “protocol testers.”

Accordingly, because Perholtz does not describe a “protocol tester” as recited in claims 1 and 15, Perholtz does not anticipate claims 1 and 15. Therefore, Applicants request that the rejection of claims 1 and 15 under 35 U.S.C. § 102(b) be withdrawn.

Claims 2, 3, and 8-14 are in condition for allowance because they depend from claim 1, which is in condition for allowance as discussed above. Applicants therefore request that the rejection of claims 2, 3, and 8-14 under 35 U.S.C. § 102(b) be withdrawn.

Conclusion

In view of the foregoing remarks, allowance of claims 1-15 is urged, and such action and the issuance of this case are requested.

Respectfully submitted,  
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